REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

Status of Claims

Claims 1-9, 15, 18-21, 23-25, 27-34, 36-54, 56-67, 69-75 and 77-83 are currently pending in the application of which claims 1, 15, 20, 47, 62 and 83 are independent. Claims 10-14, 16-17, 35, 55, 76 and 84-85 are canceled herein and claims 22, 26, 68 and 86 were previously canceled. Claims 1-9, 15-21, 23-25, 27-67 and 83-85 were rejected.

Summary of the Office Action

Claims 1-9, 20, 21, 23-25 and 27-46 were rejected under 35 U.S.C. §101 for allegedly failing to positively recite an apparatus or machine to perform a method step; and the claimed steps do not result in an article being transformed from one state to another.

Claims 1-9, 15-21, 23-25, 27-67 and 83-85 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Claims 1-9, 15-21, 23-25, 27-67, 69-85 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,151,582 to Huang et al. (hereinafter "Huang").

The aforementioned rejections are respectfully traversed for at least the reasons set forth below.

Examiner Interview Conducted

An interview was conducted between Examiner Nguyen and the Applicants' representative, Ashok Mannava, on May 25, 2010. The rejections under 101, 112 second paragraph and 103 rejection over Huang were discussed. It was agreed that the amendments provided herein overcome the rejections under 101, 112 second paragraph. It was also agreed that the amendments to independent claims 1, 15, 20, 47, 62 and 83 are not taught or suggested by Huang (103 rejection) and the pending claims are likely allowable.

Claim Rejection Under 35 U.S.C. §101

Claims 1-9, 20, 21, 23-25 and 27-46 were rejected under 35 U.S.C. §101 for allegedly failing to positively recite an apparatus or machine to perform a method step; and the claimed steps do not result in an article being transformed from one state to another.

It was agreed during the Examiner interview that the amendments overcome the 101 rejection. In particular, independent claim 20 is amended to recite a "computer" in the step for analyzing. Also, claim 1 recites a microprocessor. Accordingly, claims 1-9, 20, 21, 23-25 and 27-46 are tied to a machine and are statutory.

Claim Rejection Under 35 U.S.C. §112

Claims 1-9, 15-21, 23-25, 27-67 and 83-85 were rejected 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It was agreed during the Examiner interview that the amendments overcome the 101 rejection. Furthermore, the rejection states it is unclear how the second state is formed. In

one example, as described in paragraph 150 of the PGPUB of the present application (2005/0049911), a scoring function may be used to determine the second state.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007):

> "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

> (A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) ''Obvious to try''—choosing from a finite number of identified, predictable solutions,

> with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-9, 15-21, 23-25, 27-67, 69-85 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huang.

Claim 1 is amended to recite,

> wherein the business organization transformation opportunity scenario is at least one of a broad-outsourcing transformation scenario and a mix scenario including a mix of outsourcing and internal transformation scenario, and
>
> the broad-outsourcing transformation scenario includes a scenario whereby the human resource services are outsourced and the mix scenario includes a scenario whereby at least one of the human resource services are outsourced and at least one of the human resources are not outsourced,
>
> calculate, based on the model, a transition of the FTEs and the costs to an outsourcer as a result of implementing at least one of the broad-outsourcing scenario and the mix scenario transition.

Independent claims 15, 20, 47, 62 and 83 are amended to recite similar features. Huang discloses a system for monitoring a supply chain. Huang discloses nothing with respect to

outsourcing and calculating FTEs and costs for potential outsourcing scenerios. As such, it was agreed during the Examiner interview that the amendments to independent claims 1, 15, 20, 47, 62 and 83 are not taught or suggested by Huang and the pending claims are likely allowable.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to Deposit Account No. 50-3290.

Respectfully submitted,

Dated: June 3, 2010

By /Ashok K. Mannava/

Ashok K. Mannava
Registration No. 45,301
(703) 652-3822

MANNAVA & KANG, P.C.
11240 Waples Mill Road
Suite 300
Fairfax, VA 22030
(703) 865-5150 (facsimile)